

### REMARKS/ARGUMENTS

The Office Action dated July 25, 2008 has been carefully considered and is appreciated. For the reasons discussed below in more detail, the Applicants respectfully traverse the rejections, and it is believed that this application is in condition for allowance. Accordingly, favorable reconsideration of the pending application is respectfully requested in view of the foregoing amendments and the following remarks.

#### Status of the Application

Claims 1-20 are currently pending, with claims 1 and 19 being independent. Claims 1, 2, 4, 8-13, 15, 16, and 19 are being amended herein. No new matter has been added. Claims 5 and 20 have been cancelled without prejudice.

#### Summary of the Office Action

Claim 1, 13, 14, and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,385,589 (hereinafter “Trusheim”) in view of U.S. Patent No. 5,692,501 (hereinafter “Minturn”).<sup>1</sup> Claims 2-11, 12, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Trusheim in view of Minturn and in further view of U.S. Pub. No. 2002/012866 (hereinafter “Goetzke”). Claims 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Trusheim in view of Goetzke.

#### Discussion

##### *35 U.S.C. 101 Rejections*

Claims 1-18 are rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter. The Office Action states that the method of claims 1-18 “does not include a particular machine, nor does it transform the data identifying the patient.” Office Action, at p. 2. Independent claim 1, as amended, includes an “information server connected to the database,” and a “graphical user interface for providing ... electronic access to a health care history.” See Application, pages 15-16, Figures 1, 5-11. The foregoing amendments tie the steps of claim 1 to a **particular machine**

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<sup>1</sup> Applicants note that while the Office Action on page 3 states that rejections of claims 1, 13, 14, 16, and 17 also include U.S. Pub. No. 2002/012866 to Goetzke et al., the rejections do not actually apply Goetzke to these claims.

**or apparatus** (i.e., the “information server connected to the database”) as required by the Federal Circuit’s recent decision in *In re Bilski*. See *In re Bilski*, No. 2007-1130, slip op. at 10 (Fed. Cir. October 30, 2008). Amendments to claim 1 further clarify that the steps of “determining a first score,” “determining a second score,” “comparing,” and “providing ... result of comparison” are performed by a special-purpose “information server” specifically configured to process the health care data as recited in claim 1. Further in line with *In re Bilski supra*, the “information server” of claim 1 **transforms** the health care data associated with a physical state of each plan member to a representation of the need to intervene in the health care regimen of such plan member by displaying the result of the comparison of the first and second scores (with respective threshold values) via the graphical user interface. Additionally, as amended, claim 1 includes, for example, the “medical claim” data that represents “one or more procedures *physically* performed on or in connection with the participant.” See Application, p. 21, Figures 8-9 (emphasis added).

Additional support for the foregoing amendments to claim 1 may be found throughout the application, for example, on pages 15-16 and Figures 1, 5-11, among others. As explained on page 15 of the application, “[f]ollowing the completion of the database, the user interface is loaded with all relevant data” for the purpose of presenting the health care data for a plurality of intervention candidates to the members of a case management team via the “graphical user interface.” Additionally, “the information system server displays a list of potential ‘actionable’ plan members, who are the candidates for whom a preventative intervention may result in favorable results.” Application, page 16. In one embodiment, the list of intervention candidates presented via the graphical user interface includes plan members whose expected utilization score and action score exceed certain thresholds. *Id.*

For the foregoing reasons, independent claim 1 meets the patentable subject matter requirements of 35 U.S.C. 101. The Applicants note that dependent claims 4, 8-13, 15, and 16 have been amended to bring them in line with the foregoing amendments to claim 1. Dependent claims 2-18 include the aforementioned terms of claim 1 and, therefore, meet the patentable subject matter requirements for at least the same reasons.

*35 U.S.C. 103 Rejections*Claims 1-4, 6-18

Independent claim 1 is rejected as being unpatentable over Trusheim in view of Minturn. The Office Action cites to column 10, lines 30-34 of Trusheim for “determining a first score for an intervention candidate” and to column 10, lines 24-26 of Trusheim for “determining a second score for the intervention candidate, which second score depends on the intervention candidate’s prior consumption of a plurality of predetermined health care services.” Office Action, pp. 3-4. The Office Action admits that Trusheim fails to teach that the “first score reflects the predicted utilization of health care services” and comparing the first and second scores against first and second thresholds, respectively, as well as other elements of claim 1. Office Action, p. 4. Hence, the Office Action relies on Minturn to supply the missing features.

With respect to Trusheim, the Applicants believe that it lacks any teaching or suggestion, express or inherent, of determining a second score that reflects prior consumption of predetermined health care services. In fact, the portion of Trusheim cited by the Office Action corresponding to the “second score” (i.e., column 10, lines 24-26) is clearly *lacking a teaching of a score of any kind*. The cited section of Trusheim reads in its entirety, as follows:

“As described above, interventions 49 may set forth several SOPs for addressing a risk situation corresponding to the hospital admission data.” Trusheim, col. 10, ll. 24-26.

Further analysis of Trusheim reveals that “SOPs” referenced in the above quotation, stand for a “Standard Operating Procedure,” which is a standardized script or text that accompanies each notification. *See* Trusheim, col. 3, ll. 65-67. In fact, the very next sentence following the text cited in the Office Action, explains that “SOPs” include “contacting a provider,” “generating a letter,” or “contacting a member.” Trusheim, col. 3, ll. 26-30. Hence, the foregoing text in Trusheim merely discusses what *actions* should be undertaken in connection with a notification, and has no connection to “determining a second score for the intervention candidate . . . , which second score is derived from the intervention candidate’s prior consumption of a plurality of predetermined health care services,” as recited in claim 1.

The Applicants further note that claim 1 has been amended to further clarify that the second score reflects “relative desirability of intervention in a health care regimen of the intervention

candidate” as compared with other health care plan participants. *See* Application, page 12. Based on the foregoing, the Applicants believe that Trusheim does not disclose “determining a second score for the intervention candidate ..., which second score is derived from the intervention candidate’s prior consumption of a plurality of predetermined health care services ... the second score reflecting relative desirability of intervention in a health care regimen of the intervention candidate.” This feature is also missing from Minturn.

While the Office Action cites to column 12, lines 33-35 of Minturn for an alleged teaching of “determining a first score ... [that] reflects a predicted utilization of *future* health care services,” the Applicants respectfully disagree with the Office Action’s reading of the cited text. Relating to a “Scientific Wellness System,” this part of Minturn merely makes a general non-enabling reference to the fact that such system may be used to “improve the ability to predict an individual’s ... medical utilization.” Minturn, col. 12, ll. 33-35. However, Minturn does not disclose any way to make and to quantify such a prediction or to express it as a relative score. The Applicants request a further explanation as to where in Minturn there is disclosure of the following: (a) how is any prediction of utilization of *future* health care services expressed? (b) if it is a score, how is it computed? (c) what are the components of such score?

The “Scientific Wellness System” of Minturn includes eight specific categories, namely: (1) Healthy Relationships, (2) Mental/Emotional/Psychological Wellness, (3) Physical and Genetic Health, (4) Optimal Health and Fitness Habits/Behaviors, (5) Physical Measurements, (6) Laboratory Blood and Urine Evaluation, (7) Outlooks/Attitudes/Self-Love, and (8) Special Immune Defense Evaluation. *See* Minturn, col. 12, ll. 38-46. However, none of the categories include a prediction of *future* utilization of health care services, whether expressed as a score or otherwise. Therefore, Minturn does not disclose “determining a first score ... [that] reflects a predicted utilization of future health care services.” The Office Action already conceded that Trusheim can not be used to supply this missing feature.

Based on the foregoing, the Applicants believe that the combination of Trusheim and Minturn is missing both the “first score,” as well as the “second score,” as expressed in claim 1.

The Applicants further note that claim 1, as amended, includes a “predictive model program comprising logic to determine a likelihood of occurrence of at least one predetermined future event ... associated with utilization of health care services.” *See* Application, p. 11. This

element is also missing from the asserted combination of references. Finally, claim 1, as amended also includes the subject matter of dependent claim 5. Claim 5 has been cancelled without prejudice.

Dependent claims 2-4 and 6-18 incorporate all of the requirements of independent claim 1 and, therefore, are also patentable for at least the same reasons.

#### Claims 19-20

Claims 19 and 20 are both rejected as being unpatentable over Trusheim in view of Goetzke, Office Action, p. 11. In this amendment, independent claim 19 has been amended to include the subject matter of claim 20. Therefore, dependent claim 20 has been cancelled without prejudice. As amended, claim 19 recites “wherein one of the plurality of flags represents the likelihood that an intervention candidate will claim disability under a disability insurance plan.” The Office Action relies on Trusheim to supply this element by stating that “Trusheim discloses a computerized system which tracks all claims as well as all insurance claims” and assuming that “it is obvious that the system described will enable a user to determine the likelihood of a patient filing a disability claim.” Office Action, p. 12 (citing to parts of Trusheim representing access to claims data). The Applicants respectfully request a further clarification as to how *mere access* to medical claims data makes *prediction of a likelihood* of a future disability claim “obvious.” To the contrary, as described in the application, elaborate multivariate regression analysis is employed by the present application to come up with a predictive model that contains variables related to the likely future disability event. *See* Application, page 11, par. 0032.

Therefore, neither Trusheim nor Goetzke disclose any flags representing the likelihood that an intervention candidate will claim disability under a disability insurance plan. In view of this missing element, the Applicants respectfully request allowance of independent claim 19.

#### Conclusion

Applicants respectfully submit that the patent application is in condition for allowance. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,

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